REMARKS

Response to Priority

The Examiner acknowledged the claim for the benefit of a prior-filed application under 35 U.S.C. §119(e) or under 35 U.S.C. §§120, 121, or 365(e), but has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. [1].

Response to Information Disclosure Statement

The Examiner indicated that the information disclosure statement filed by the applicant on 12/05/2003 failed to comply with 37 C.F.R. §1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed. Applicants have enclosed herewith the foreign patent document and non-patent literature publication that was listed on the aforementioned IDS.

Response to Claim Objections

Claim 29 is objected to by the Examiner because the claim mentions the device having an "inner lumen", but there is no prior mention of the inner lumen leading up to claim 29. The term "inner lumen" is mentioned three times in claim 29, the first time in line 2 ("an inner lumen") and in lines 4 and 6 ("the inner lumen"). Applicants believes that there is proper antecedent basis for the expression "the inner lumen".

Claim 34 is objected to by the Examiner because the claim mentions accessing the sentinel lymph node with "the cannula" but there is no prior mention

of the cannula leading up to claim 34. In response the claim has been amended by changing the term "cannula" to "accessing and anchoring device".

Applicants submit that the informalities have been overcome.

Response to Claim Rejections Under 35 USC §102

Claims 37-39, 44, 51, 66, 73 are rejected by the Examiner under 35 U.S.C. §102(b) as being anticipated Ritchart et al (U.S. pat. No. 5,810,806). The Examiner contends that element 18e found in Figures 23-27 refers to an anchoring member. However, element 18e is a support stem and has no anchoring function particularly for securing the distal end of the device to the node to be accessed. Applicants have added the clarification that the anchoring element is configured to secure the distal end of the shaft to the node to be accessed. This clarifies the function of the anchor which is clear from applicants' specification. The element 18e of the Ritchart reference neither anchors in a general sense nor secures the distal end of the device to the node to be accessed as called for in claims 37, 44 and 66.

Response to Claim Rejections Under 35 USC §103

Claims 25-34, 40-43, 52-54, 74-76 are rejected by the Examiner under 35 U.S.C. §103(a) as being unpatentable over Ritchart et al. in view of Mulier et al. (U.S. Pat. No. 5,431,649). However, applicants believe that there is no suggestions to combine the teachings of Ritchart et al. with the teachings of Mulier et al. Specifically, the helical coil electrode of Mulier et al. would not be used with the tissue cutting electrode of Ritchart. Movement of the tissue cutting member of

the Ritchart et al. device as described would interfere and come into contact with the helical screw electrode of the Mulier et al. reference. Moreover, there is no suggestion how this problem would be overcome.

Claims 35, 36 are rejected by the Examiner under 35 U.S.C. §103(a) as being unpatentable over Ritchart et al. in view of Mulier et al. as applied to claim 26 above, and further in view of Clayman (U.S. Pat. No. 5,628,746). However, Clayman does not make up for any of the deficiencies of the Ritchart et al. and Mulier et al. references. Moreover, the device described by Clayman involves an expandable cutting element that is spaced proximal to the distal end of the device, so there is little likelihood that the Clayman reference would be considered as teaching an electrode on the distal end to facilitate passage of the device through tissue to a region adjacent to the node to be accessed.

Claims 45 and 67 are rejected by the Examiner under 35 U.S.C. §103(a) as being unpatentable over Ritchart et al. in view of Mulier et al., and further in view of Goble et al. (U.S. pat. No. 5,944,715), but Globle et al. fails to make up for the deficiencies of the Ritchart et al. and Mulier et al. references. Moreover, there is no suggestion of providing an end tissue cutting electrode for providing access to a node to which the device is to be secured. For example, the device of Globle is designed for use with a conductive fluid at the treatment site.

Claims 46-48 are rejected by the Examiner under 35 U.S.C. §103(a) as being unpatentable over Ritchart et al. in view of Clayman. As discussed above, Clayman fails to make up for the deficiencies of the Ritchart et al reference, so the combined teachings of these references would not meet every feature of the invention

claimed in the rejected claims. Moreover there is no suggestion of combining the teaching of these references in either of these references.

Response to Allowable subject Matter

The applicants note with appreciation that claims 49, 50, 71, and 72 are directed to patentable subject matter. However, applicants believe that the independent claims from which these claims depend are by themselves directed to patentable subject matter, so claims 49, 50, 71, and 72 need not be rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusions

The applicants believe that the pending claims as amended above are directed to patentable subject matter. Reconsideration and an early allowance of these claims are earnestly solicited.

Respectfully submitted,

By: _____

Edward J. Lynch
Registration No. 24,422
Attorney for Applicants

DUANE MORRIS LLP
One Market
Spear Tower, Suite 2000
San Francisco, CA 94105
Telephone: (415) 371-2200
Facsimile: (415) 371-2201
Direct Dial: (415) 371-2267